

**Remarks/Arguments:**

**Preliminary Matters**

This Amendment is being filed together with a Request For Continued Examination. It is respectfully requested that this Amendment be entered and the claims be reconsidered in accordance with the remarks set forth herein.

The specification is amended to correct a typographical error. No new matter is added.

**Claim Rejections Under 35 U.S.C. §102**

Claims 1-8 stand rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,159,215 ("Urbahns et al."). Applicants respectfully traverse the rejection of these claims.

"[A]n invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim. The identical invention must be shown in as complete detail as is contained in the patent claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (citations omitted) (emphasis added).

Independent claim 1 recites "[a]n implant insertion device comprising: a handle; an insertion rod attached to said handle; and an implant gripper attached to said insertion rod, said implant gripper including: a gripping surface; a first pin extending from and fixed relative to said gripping surface; and a second pin extending through and movable relative to said gripping surface between a first position wherein the second pin extends from the gripping surface a distance x and a second position wherein the second pin extends a distance less than x from the gripping surface."

Urbahns fails to teach or suggest each limitation of the claimed invention. In contradistinction, as illustrated in Fig. 10 thereof, each tooth 278 is formed integrally with and fixed relative to the gripping surface. It is respectfully submitted that independent claim 1 is in condition for allowance. Claims 2-5 depend from claim 1, and therefore, should also be allowed at least as dependent upon their allowable base claim.

Independent claim 6 recites "[a] method of engaging an implant with an implant insertion device, comprising the steps of: (a) retracting a movable pin relative to a gripping

surface of the implant insertion device; (b) positioning the implant adjacent to the gripping surface such that a fixed pin extending from the gripping surface extends into an insertion pin hole of the implant; and (c) extending the movable pin relative to the gripping surface such that the movable pin extends into a second insertion pin hole of the implant, thereby effectively reversibly locking the implant onto said device.”

As explained above with respect to claim 1, each tooth 278 of Urbahns et al. is formed integrally with and fixed relative to the gripping surface and is not moved relative to the gripping surface. Urbahns fails to teach or suggest each limitation of the claimed invention. It is respectfully submitted that independent claim 6 is in condition for allowance. Claim 7 depends from claim 6, and therefore, should also be allowed at least as dependent upon its allowable base claim.

Similar to claim 6, independent claim 8 recites “[a] method of insertion of an implant with an implant insertion device, comprising the steps of: (a) attaching the implant to the implant insertion device by retracting a movable pin relative to a gripping surface of the implant insertion device; positioning the implant adjacent to the gripping surface such that a fixed pin extending from the gripping surface extends into an insertion pin hole of the implant, and extending the movable pin relative to the gripping surface such that the movable pin extends into a second insertion pin hole of the implant; (b) inserting said implant in a spinal column; and (c) detaching said implant from said implant insertion device by retracting said movable pin from said second insertion pin hole of said implant, and detaching said fixed pin of said implant gripper from said insertion pin hole of the implant.”

Again, each tooth 278 of Urbahns et al. is formed integrally with and fixed relative to the gripping surface and is not moved relative to the gripping surface. Urbahns fails to teach or suggest each limitation of the claimed invention. It is respectfully submitted that independent claim 8 is in condition for allowance.

Similar to independent claim 1, independent claim 9 recites *inter alia*, “an implant insertion device comprising: a gripping surface; a first pin extending from and fixed relative to said gripping surface; and a second pin extending through and movable relative to said gripping surface between a first position wherein the second pin extends from the gripping surface a distance x and a second position wherein the second pin extends a distance less than x from the gripping surface. . . .” As explained above, Urbahns et al. fails to teach or suggest the claimed

invention. It is respectfully submitted that independent claim 9 is in condition for allowance. Claims 10-19 depend from claim 9, and therefore, should also be allowed at least as dependent upon their allowable base claim.

Applicants respectfully request reconsideration and allowance of the pending claims.

## Conclusion

For all of the above reasons, pending claims 1-19 in the application are believed to be in condition for allowance, which action is earnestly solicited.

If the Examiner believes an interview, either personal or telephonic, will advance the prosecution of this matter, it is respectfully requested that the Examiner contact the undersigned to arrange the same.

Respectfully submitted,

Jonathan H. Spadt, Reg. No. 45,122  
Glenn M. Massina, Reg. No. 40,081  
Attorneys for Applicants

JHS/GMM/ap

Dated: July 14, 2006

P.O. Box 980  
Valley Forge, PA 19482  
(610) 407-0700

The Director is hereby authorized to charge or credit Deposit Account No. 18-0350 for any additional fees, or any underpayment or credit for overpayment in connection herewith.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on: .

22313-1450 on:  
7/4/00  
Av. Pineda